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EXAMINER

RAHIMI, IRAJ A

ART UNIT PAPER NUMBER

2622

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/574,553

Applicant(s)

KUTTY, NANDA

Examiner

(Iraj) Alan Rahimi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 23, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In papers filed on February 23, 2004, applicant amended claims 1, 25 and 27.

Amendment to claim 1, removes the 112 rejection.

Response to Arguments

2. Applicant's arguments filed on September 16, 2002 have been fully considered but they are not persuasive.

In response to applicant's arguments, the recitation for a *computer network* has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Even if the limitation for a computer network were in the main body of the claim, it is well known that stand-alone computers could be connected in a network environment.

Applicant additionally argues that Knodt does not disclose or suggest the selection of front and back cover sheets from a different tray. Examiner concedes that Knodt does not teach this limitation explicitly (emphasis added) as stated in the first office action. However, Knodt suggests this arrangement in column 4, lines 54-59 by stating the print media is brought forward from a main paper tray or from auxiliary paper trays 112 or 114. The auxiliary paper trays may

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well be used for holding the front and back cover having different color or attributes. Examiner provided the teaching of Desmond for supply of cover sheets from different paper trays.

Examiner disagrees with the applicant that Desmond teaches away from the instant application. Applicant has not fully considered the teachings of Desmond; rather applicant is reciting phrases from Desmond without full understanding of his invention.

Desmond discloses in column 5, lines 55-67 and column 6, lines 1-12 that printing of three copies of a booklet having a front and back cover can be expedited by associating like wise pages of a document together and so called forming a burst. For instance, the back cover of the first copy set can be combined with the front cover of the second copy set as a burst, since they have similar characteristics (e.g. heavier stock). Desmond certainly teaches the assembly of different pages of a document having front and back cover sheet, which is central to the instant application. Therefore not only Knodt and Desmond are analogous art, their combination is also very practical for keeping different stocks of paper in separate trays as well as additional printing speed gained using the burst concept.

Applicant additionally argues that Desmond does not teach printing a first page on a front face of a sheet of paper and a second page on a second sheet of paper. Examiner relied upon Knodt in column 7, lines 20-27 for this limitation.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knodt et al. (US patent 5,124,731) in view of Desmond et al. (US patent 5,991,516).

Regarding claim 1, Knodt discloses a method of processing a print job comprised of a document including a first page 1 through a last page n, wherein a control unit receives the print job from a computer workstation in a computer network and wherein the document was created at the computer workstation using an application program, the method comprising:

(a) the control unit 7 interpreting a set of instructions in the print job and causing a printer to obtain a sheet of paper from a first paper source (paper tray 112 or 114), the first sheet comprising a top cover (Figs. 3, 7 and 8) ;

(b) the control unit determining whether the top cover is one-sided, two-sided, or blank and (column 7, lines 20-33);

(i) if the top cover is one-sided, the control unit causing the printer to print a first page of the document on one face of the first sheet of paper (column 7, lines 20-33; column 7, lines 61-67; column 7, lines 1-12 and Fig. 11B);

(ii) if the top cover is two-sided, the control unit causing the printer to print a first page of the document on a front face of the first sheet of paper and print a second page of the document on a back face of the first sheet of paper (column 7, lines 20-33 and Fig. 11A);

(iii) if the top cover is blank, the control unit causing the printer to output the first sheet of paper with a blank front face and a blank back face (Fig. 10 and column 11, lines 15-19);

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(c) the control unit causing the printer to obtain one or more subsequent sheets of paper from a second paper source (paper tray 110 and Figs. 11A-D);

(d) the control unit causing the printer to print one or more pages from a remainder of the document using the one or more subsequent sheets of paper, wherein each page of the remainder of the document is printed on only one face of each of the one or more subsequent sheets of paper (Fig. 12A).

Although Knodt discloses different paper trays and different paper types to select, he does not specifically mention that front and back cover sheets are selected from different trays. Desmond discloses in column 5, lines 55-67 and column 6, lines 1-12 selecting front and back cover from different trays. Knodt and Desmond are analogous art because they are from the same field of endeavor that is printing multi page documents with front and back cover. Therefore, it would have been obvious to a person skilled in the art, at the time of invention to use different trays for supply of the cover sheets to avoid mixing of different type stocks.

Regarding claim 2, Knodt discloses the method of printing a document of claim 1, wherein if the top cover is two-sided, the control unit causes the printer to print a first page of the document on a front face of the first sheet of paper (Fig. 11B).

Regarding claim 3, Knodt discloses the method of printing a document of claim 1, wherein if the top cover is two-sided, the control unit causes the printer to print a first page of the document on a back face of the first sheet of paper (Fig. 11C).

Regarding claim 4, Knodt discloses the method of printing a document of claim 1, further comprising:

(a) the control unit causes the printer to obtain a last sheet of paper from the first paper source, the last sheet of paper comprising a bottom cover(column 7, lines 12-33 and Fig. 12A);

(b) the control unit causes the printer to print the last page of the document on a face of the last sheet of paper(Fig. 12A).

Regarding claim 5, Knodt discloses the method of printing a document of claim 4, wherein the last page of the document is printed on a front face of the last sheet of paper (Fig. 12A).

Regarding claim 6, Knodt discloses the method of printing a document of claim 4, wherein the last page of the document is printed on a back face of the last sheet of paper (Figs. 11D and 12D).

Regarding claim 7, Knodt discloses the method of printing a document of claim 6, wherein a second to last page of the document is printed on a front face of the last sheet of paper (Fig. 12D).

Regarding claims 8, 17, 21, 25 and 27 arguments analogous to those presented for claim 1, are applicable.

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Regarding claims 9 and 18 arguments analogous to those presented for claim 2, are applicable.

Regarding claims 10 and 19, arguments analogous to those presented for claim 3, are applicable.

Regarding claims 11, 20, 22 and 26 arguments analogous to those presented for claim 4, are applicable.

Regarding claim 12, arguments analogous to those presented for claim 2, are applicable.

Regarding claim 13, arguments analogous to those presented for claim 6, are applicable.

Regarding claim 14, arguments analogous to those presented for claim 7, are applicable.

Regarding claim 15, Knodt discloses the control unit of claim 11, wherein the top cover is one-sided and the bottom cover is two-sided. Fig. 10 shows options for printing on front and backside of cover with images on one side or two sides.

Regarding claim 16, Knodt discloses the control unit of claim 11, wherein the top cover is two-sided and the bottom cover is one-sided. Fig. 10 shows options for printing on front and backside of cover with images on one side or two sides.

Regarding claim 23, Knodt discloses the computer program product on a computer workstation of claim 21, wherein the dialog window includes user-selectable checkboxes coupled to a label describing the formatting features for the document (Fig. 10).

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Regarding claim 24, Knodt discloses the computer program product on a computer workstation of claim 21, wherein the dialog window includes a pull-down menu that permits a user to choose a cover paper source from a list of one or more paper sources (Fig. 9).

Regarding claim 28, Knodt discloses the printing device of claim 27, the software additionally configured to cause the printing device to output a last sheet of paper from the cover paper source and print a last page of the document on a front face or a back face of the last sheet of paper (Figs. 8, 9, 10 and 11A-D).

Regarding claim 29, Knodt discloses the printing device of claim 27, wherein the printing device comprises a control unit (controller 7) coupled to a print engine (printer 8).

Regarding claim 30, Knodt discloses the printing device of claim 27, wherein the print engine and the control unit are a single unit (Fig. 2, item 1).

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Iraq) Alan Rahimi whose telephone number is 703-306-3473. The examiner can normally be reached on Mon.-Fri. 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.


Alan Rahimi
April 22, 2004


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